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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,694	03/03/2005	Hugo Camenzind	L/A/I-22745/A/PCT	5272
324	7590	03/14/2008		
JoAnn Villamizar			EXAMINER	
Ciba Corporation/Patent Department			GOLBOY, JAMES C	
540 White Plains Road				
P.O. Box 2005			ART UNIT	PAPER NUMBER
Tarrytown, NY 10591			1797	
MAIL DATE	DELIVERY MODE			
03/14/2008	PAPER			

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/526,694	<b>Applicant(s)</b> CAMENZIND ET AL.
	<b>Examiner</b> James Goloboy	<b>Art Unit</b> 1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 03 March 2005.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-8 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date 5/27/05
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
3. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cox (U.S. Pat. No. 4,882,077) in view of Amende (DE 2,054,649).

In column 2 lines 7-27, Cox discloses metalworking fluids comprising a paraffin oil and an emulsifier, which can be diluted to form an oil-in-water emulsion. In column 3 lines 24-27 Cox discloses that the composition is first made in concentrate form without water, as recited in claim 7. The paraffin oil meets the limitations of the base oils of claims 1-6 and 8. In column 4 lines 20-25 Cox discloses that any oil-in-water emulsifier can be used in the composition, but does not specifically disclose the compounds of claims 1-5.

Amende, on pages 9-12, discloses the preparation of a compound by the reaction of an acrylic acid ester and alkylamines such as laurylamine, stearylamine, and oleyl amine, followed by further reaction with maleic anhydride. On page 6 Amende discloses that succinic anhydride can be used in place of maleic anhydride. When succinic anhydride is used, the reaction of Amende is the same as those disclosed in the examples in the specification of the current application, and therefore the product has a structure meeting the limitations of claims 1-6 and 8. On page 1, Amende discloses that the compound is useful as an emulsifier, and can be an ammonium salt. The use of the compound of Amende as the emulsifier in the metalworking fluid composition of Cox meets the limitations of claims 1-6 and 8.

It would have been obvious to one of ordinary skill in the art to use the compound of Amende in the metalworking fluid of Cox, as Amende teaches that the compound acts as an emulsifier.

4. Claims 1-6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubo (U.S. Pat. No. 5,362,375) in view of Amende.

In column 1 lines 5-12, Kubo discloses an oil composition substantially free from thermal deterioration and carbonaceous deposition at high temperatures. In column 2 lines 21-61, Kubo discloses that the composition comprises a base oil, meeting the limitations of component (b) of claims 1-5, and in column 5 lines 11-21 discloses that the compositions can be used as engine oils or gear oils, as recited in claim 6. In

column 4 line 66, Kubo discloses that the composition can further comprise an emulsifier, but does not disclose specific suitable emulsifiers.

The discussion of Amende in paragraph 3 above is incorporated here by reference. The use of the compound of Amende in the composition of Kubo meets the limitations of claims 1-6 and 8, and would have been obvious to one of ordinary skill in the art as Amende teaches that the compound acts as an emulsifier.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is (571)272-2476. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Calderola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JCG

/Glenn A Caldarola/  
Acting SPE of Art Unit 1797